

REMARKS

In the Office Action mailed April 20, 2004, claims 1-7 and 24 were rejected under 35 U.S.C. 112, second paragraph.

The Examiner is thanked for a telephone interview on June 30, 2004 where the rejection was discussed. The interview is discussed in more detail below.

The Amendments

Claims 1 and 24 have been amended to remove variable "a" for clarity. This amendment to claims 1 and 24 is supported by the definition of the variables containing "a". Claims 1 and 24 have been amended to replace the variable "R" with the constituents listed in the definition of R. This amendment to claims 1 and 24 is supported by the definition of "R" in the claims. Claim 24 has also been amended to clarify the preamble. No new matter is added by any amendment.

35 U.S.C. 112, second paragraph rejection

In the Office Action mailed April 20, 2004, claims 1-7 and 24 were rejected under 35 U.S.C. 112, second paragraph. The points in the Office Action are discussed in turn.

1. Ra definition

The Office Action stated: "The claims are indefinite in defining 'Ra'." In response, the variable "a" has been removed from the structures in independent claims 1 and 24. This amendment is made for clarity and was discussed in the Interview. The variable "a" was intended to indicate the variables were present ($a=1$) or not ($a=0$). If $a=0$, the variable is H. Since the definitions for the variables that contained "a" include H as a possibility, the scope of the claims is not changed by the removal of the variable. In view of the above, it is believed this portion of the rejection is overcome.

2. T variable

The Office Action stated: "The claims are also indefinite as to the phrase 'T is independently CR, NR, N, S or O;' There is no T in the presented formula." In response, it is respectfully noted there is a "T" variable in independent claims 1 and 24 in the bottom ring of the structure. In the Interview, the Examiner acknowledged the presence of the T variable. In view of the above, it is believed this portion of the rejection is overcome.

3. "a" variable

The Office Action stated: "The phrase 'a is 0 or 1;' fails to clarify the intended meaning." It is believed this portion of the rejection is overcome with the amendments to the claims discussed above in relation to the Ra variable.

4. R variable

The Office Action stated: "The phrase 'R1, R3, R4 and R5 independently, R,' also lacks a clear meaning." In response, the substituents included in the definition of variable R are specifically incorporated in the claim for clarity. This amendment was discussed in the Interview. In view of the above, it is believed this portion of the rejection is overcome.

5. Section in the claims starting with -OR and ending 3 lines after the first line with -R

The Office Action stated: "The section in the middle of page 3 of the claims starting with -OR, and ending 3 lines after the first line with -R, also fails to clarify the intended meaning." The noted section of the claims was discussed in the Interview. The section of the claims starting with -OR and ending 3 lines after the first line with -R are substituents that can be present in the claims. It is believed this explanation overcomes this portion of the rejection.

6. Expression of aldose reductase

The Office Action stated: "Claims 24 is also indefinite as to the phrase 'and expression of aldose reductase in the retina', which fails to set forth the intended meaning." Applicant respectfully disagrees with this rejection. In the Interview with the Examiner, the Examiner stated no specific disorder (complication of diabetes) associated with expression of aldose reductase was present in the claim.

In response, it is noted that an increase in aldose reductase expression in the retina is a disorder or complication of diabetes that the compounds of the invention are used to treat. As stated in the record (Response submitted June 11, 2003 to the Office Action mailed March 18, 2003; specification, page 1, line 35 through page 2, line 4; Submission under 37 C.F.R. 1.114 mailed September 17, 2003, for example), diabetes causes well-known and well-defined ocular complications. Increased expression of the enzyme aldose reductase in the retina is one of the well-known and well-defined ocular complications of diabetes. (see citations above). In patients with diabetes, there is an increased level of aldose reductase expression in the retina. Experiments have been performed by the inventors that show the compounds of the invention inhibit aldose reductase expression in the retina (specification page 26, line 1 through page 27, line 4, for example).

Claim 24 has been amended to clarify disorders or complications of diabetes that are treated using the compounds of the invention. In view of the above arguments and amendments, it is believed the claims particularly point out and distinctly claim the subject matter which the applicant regards as his invention and it is believed this portion of the rejection is overcome.

CONCLUSION

In view of the above arguments and amendments, it is believed the rejection is overcome. Reconsideration and withdrawal of the rejection is respectfully requested. If there are any issues remaining to passage of the case to issuance, the Examiner is respectfully requested to telephone the undersigned.

It is believed that the present submission does not require the payment of any fees. If this is incorrect however, please charge any fees required, including any extensions of time required, to Deposit Account No. 07-1969.

Respectfully submitted,

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